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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,157	12/14/2001	Anja Knuppel	Beiersdorf 756 -KGB/BSL	1726
7055	7590	07/05/2006	EXAMINER KANTAMNENI, SHOBHA	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			ART UNIT	PAPER NUMBER

1617

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/017,157	KNUPPEL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Shobha Kantamneni	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 19-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 19-64 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### **Election/Restrictions**

Applicant's amendment submitted on 04/10/2006 is acknowledged, wherein claims 1, 3-18 have been cancelled, and new claims 19-64 have been added.

Currently claims 19-64 are pending.

In view of the instant amendment, wherein new claims 19-64 have been added,

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 19-21 (in part), 22-24, and 28-40 (in part), drawn to a method of protecting skin from the damaging effects of exposure to UV light, said method comprising (1) topically applying to skin an effective amount of a cosmetic oil-in-water formulation comprising (i) at least one UV filter substance and (ii) at least one water-soluble or water-dispersible anionic polyurethane and a salt thereof; and (2) forming a moisture-resistant layer on said skin, classified in class 514, subclass 553, 622, 772.3, ; class 424, subclass 59.
- II Claims 19-21 (in part), 25-27, and 28-40 (in part), drawn to a method of protecting skin from the damaging effects of exposure to UV light, said method comprising (1) topically applying to skin an effective amount of a cosmetic oil-in-water formulation comprising (i) at least one UV filter substance and (ii) at least one water-soluble or water-dispersible cationic polyurethane, a cationic polyurea and a salt thereof; and (2)

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forming a moisture-resistant layer on said skin, classified in class 514, subclass 642, 772.3; class 424, subclass 59.

- III Claims 41-43 (in part), 44-46, and 50-63 (in part), drawn to a method of improving the water resistance of a cosmetic formulation which contains at least one UV filter substance, wherein the formulation comprises at least one film-forming, water-soluble or water-dispersible anionic polyurethane and a salt thereof, classified in class 514, subclass 553, 772.3; class 424, subclass 401.
- IV Claims 41-43 (in part), 47-49, and 50-63 (in part), drawn to a method of improving the water resistance of a cosmetic formulation which contains at least one UV filter substance, wherein the formulation comprises at least one film-forming, water-soluble or water-dispersible cationic polyurethane, a cationic polyurea and a salt thereof, classified in class 514, subclass 588, 642, 772.3; class 424, subclass 401.
- V Claim 64, drawn to a method of improving the water resistance of an O/W formulation, wherein the method comprises incorporating at least one film forming water-soluble or water-dispersible polyurethane, classified in class 514, subclass 772.3, 938; class 424, subclass.

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In

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the instant case the different inventions are drawn to a method of protecting skin from damaging effects of exposure to UV light employing different cosmetic or dermatological formulations, and thus will have different modes of operation and different effects. The effects of the methods of using Groups I to II are distinct from each other because the polyurethanes used in the dermatological formulations differ by a significant structural feature, and thus one does not render the other obvious.

Inventions I-II and III-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions or different effects. Groups I-II are drawn to a method of protecting skin from damaging effects of exposure to UV light and will have different functions or effects from Groups III-V which are drawn to method of improving the water resistance of a cosmetic or dermatological formulation.

Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to a method of improving the water resistance of a cosmetic or dermatological formulation employing different film forming polyurethanes, and thus will have different modes of operation and different effects.

Inventions III-IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of

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operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to a method of improving the water resistance of formulation employing different components, for example Groups III-IV contain UV filter substance, and thus will have different modes of operation and different effects.

The above inventions differ as distinct methods, a reference which would anticipate, or make obvious, any inventions from groups I-V would not necessarily obviate or anticipate, the inventions in any other group.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, as exemplified by the different classes and subclasses, restriction for examination purposes as indicated is proper. Further, a search for the invention of the 5 groups would not be coextensive because a search indicating the method of protecting skin from damaging effects of exposure to UV light is novel or unobvious would not extend to a holding that method of improving the water resistance of a cosmetic formulation itself is novel or unobvious; similarly, a search indicating that the method of improving the water resistance of a cosmetic formulation is known or would have been obvious would not extend to a holding that the method of protecting skin from damaging effects of exposure to UV light is known or would have been obvious. Therefore, restriction for examination purposes as indicated is proper.

In addition, because of different classification of Groups, for example, Invention I drawn to a method of protecting skin from the damaging effects of exposure to UV light,

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is classified in 424 subclass, 59. Invention III drawn to a method of improving the water resistance of a cosmetic formulation is classified in 424, subclass 401; a serious burden is imposed on the examiner to perform a complete search in both the patent and non-patent literature.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one or more claim remaining in the application. Any amendment of inventorship must be accompanied by request under 37 CFR 1.48(b) and by fee required under 37 CFR 1.17(i).

A telephone call to the applicant's agent to request an oral election was not made, due to the complexity of the restriction.

### ***Conclusion***

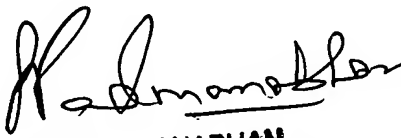
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shobha Kantamneni whose telephone number is 571-272-2930. The examiner can normally be reached Monday-Friday on 8 am – 4 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shobha Kantamneni  
Patent Examiner  
Art Unit : 1617

  
**SREENI PADMANABHAN**  
**SUPERVISOR, PATENT EXAMINER**